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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,974	02/07/2002	Robert Koelliker	1785	7263

7590 02/03/2004
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EXAMINER

WILSON, DONALD R

ART UNIT PAPER NUMBER

1713

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,974

Applicant(s)

KOELIKER, ROBERT

Examiner

Donald R Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 and 18 is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20010906. 6) ☐ Other:

DETAILED ACTION

Response to Restriction Requirement

1. Applicant's election of the inventions of Group I, now Claims 11, 16 and 17-18, in Paper No. 20030702 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 19-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

Response to Election of Species Requirement

2. Applicant's election of the species of (a) the copolymer of butyl acrylate, styrene and gamma-methacryloxypropyltrimethoxysilane as the silanol group containing polymer, in Paper No. 20031212, and (b) the specie of glycol as the protective group, in Paper No. 20031022, is acknowledged. The election of a species of the form of polymer is moot as applicant has restricted independent Claim 1 to a powder. Further, the elected species of the invention are deemed to be allowable and the search was extended to other species of the generic claim.

Claim Rejections - 35 USC § 112, Second Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-17 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claims 16 and 17 fail to distinctly point out the invention and narrow the scope of what is claimed in parent Claim 11. The polyols are specifically defined in a Markush group in Claim 11, which do not include polymeric alcohols or polyvinyl alcohol. (It is also noted that DE'408 discloses silanol group containing polymers which become protected with polyvinyl alcohol (see Examples 1 and 7) for reasons as set forth in the International Preliminary Search Report.)

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Allowable Subject Matter

5. No prior art has been found which suggests or discloses the redispersible polymer compositions of instant Claim 11. Gentle discloses organosiloxane compositions that are reaction products of a silane compound with three hydrolyzable groups, a polyhydric alcohol with a further organofunctional group, and a polyhydric alcohol without a further organofunctional group. The reaction products are used in curable polyorganosiloxane compositions which would ultimately contain protected silanol groups. However, such products would not be redispersible. Miyazono discloses epoxy resin compositions wherein the composition contains both a polyepoxide function and an alkoxysilyl function. The latter is introduced for example by copolymers of gamma- methacryloxypropyltrimethoxysilane. The compositions may further contain as a chain-extender or cross-linker a minor amount of a polyhydric alcohol such as ethylene glycol, trimethylolpropane, etc. However, the reaction products of such compositions would not be expected to be redispersible.

Objection to Abstract

6. The abstract of the disclosure is objected to. The abstract of the disclosure is objected to because it contains more than one paragraph. Correction is required. See MPEP § 608.01(b).

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 571-272-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 571-273-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

Donald R Wilson
Primary Examiner
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